

### **REMARKS**

Applicant hereby traverses the current rejections, and requests reconsideration and withdrawal of such in light of the amendments and remarks contained herein. Claims 1-18 are pending in this application.

#### **Rejection Under 35 U.S.C. § 112, first paragraph**

Claim 8-9, and 17-18 stand rejected under 35 U.S.C. 112, first paragraph, as being non-enabling. In the Final Action, the Examiner reiterates his position that “the specification does not contain a clear and concise description regarding the manner of extracting parameters by scanning a user’s hard drive.” (*see* Final Action, pg. 6). The Applicant respectfully points out that the claimed invention is drawn to “extracting a plurality of parameters from a media,” not scanning a user’s hard drive. The media from which a plurality of parameters may be extracted includes a CD or computer harddrive. (paragraph [0027]). The Applicant further points out that a software process extracts the parameters from the media. (see abstract, paragraph [0022]). Therefore, it is not necessary for one to “make a media file stored on a computer,” as the Examiner claims (Final Action, pg. 2). Put simply, the disclosed software process executes the extraction process. As such, one of ordinary skill in the art could practice the claimed invention.

#### **Rejection Under 35 U.S.C. § 102(b)**

Claims 1-7 and 10-16 stand rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 6,061,680 to Scherf et al (hereinafter “Scherf”).

“Anticipation requires the presence in a single prior reference disclosure of each and every element of the claimed invention, arranged as in the claim.” *Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 221 USPQ 481, 485 (Fed. Cir. 1984); *citing Connell v. Sears, Roebuck & Co.*, 722 F.2d 1542, 220 USPQ 193 (Fed. Cir. 1983).

Claim 1 requires “extracting a plurality of parameters from a media including a known media sample during a playing of the media by a user” and “processing the plurality of parameters into a plurality of fingerprints/landmarks used in a recognition process.” In the

Final Action, the Examiner indicates that each of these limitations are satisfied by a single citation- Scherf, at col. 5, lines 44-55. (*see* Final Action, pgs. 3 & 4). However, at this citation Scherf merely describes “a unique identifier based on the number and lengths of tracks [of a CD]...the identifier would be a concatenation of these lengths.” (*see* Scherf col. 5, lines 47-50). As the Applicant best understands, the Examiner relies upon a unique identifier composed of track lengths to satisfy each of “a plurality of parameters” and “a plurality of fingerprints/landmarks.” The Applicant respectfully submits this cannot be correct as a single item (i.e., a unique identifier) cannot satisfy two separate and distinct limitations (i.e., a plurality of parameters and fingerprints/landmarks). Even if the Examiner were correct in asserting that the unique identifier of Scherf satisfies “a plurality of parameters,” which the Applicant does not concede as true, the same unique identifier could not satisfy the processed plurality of parameters, or fingerprints/landmarks. Put simply, the music tracks that comprise the unique identifier of Scherf remain unchanged throughout the process disclosed by Scherf. At no point are the music tracks of Scherf modified or processed in any way. Notably, the word “process” is not even contained within the disclosure of Scherf. Thus, Scherf does not teach all of the claimed limitations. Therefore, the Applicant respectfully asserts that for the above reasons claim 1 is patentable over the 35 U.S.C. § 102 rejection of record.

Claims 2-7 depend from base claim 1, and thus inherit all limitations of claim 1. Each of claims 2-7 set forth features and limitations not recited by Scherf. Thus, the Applicant respectfully asserts that for at least the reasons set forth above with respect to claim 1, the claims 2-7 are patentable over the 35 U.S.C. § 102(b) rejection of record.

Claim 10 requires “extracting a plurality of parameters from a media” and “processing the plurality of parameters into a plurality of fingerprints/landmarks used in a recognition process.” In the Final Action, the Examiner indicates that each of these limitations are satisfied by a single citation- Scherf, at col. 5, lines 44-55. (*see* Final Action, pgs. 3 & 4). However, at this citation Scherf merely describes “a unique identifier based on the number and lengths of tracks [of a CD]...the identifier would be a concatenation of these lengths.” (*see* Scherf col. 5, lines 47-50). As the Applicant best understands, the Examiner relies upon a unique identifier composed of track lengths to satisfy each of “a plurality of parameters” and “a plurality of fingerprints/landmarks.” The Applicant respectfully submits this cannot

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Claims 11-16 depend from base claim 10, and thus inherit all limitations of claim 10. Each of claims 11-16 set forth features and limitations not recited by Scherf. Thus, the Applicant respectfully asserts that for at least the reasons set forth above with respect to claim 10, the claims 11-16 are patentable over the 35 U.S.C. § 102(b) rejection of record.

In view of the above remarks and amendments, the Applicant believes the pending application is in condition for allowance. The Applicant believes no additional fee is due with this response, other than the fees addressed in the accompanying transmittal. However, if an additional fee is due, please charge our Deposit Account No. 06-2380, under Order No. 69323/P004US from which the undersigned is authorized to draw.

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Respectfully submitted,

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